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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 10/790,359 | 03/01/2004 | Caleb C. Rutan | INST-P01 | 9337 |
| 49142 | 7590 | 06/24/2010 | EXAMINER | |
| SCHOX PLC | | | WEST, THOMAS C | |
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| San Francisco, CA 94107 | | | | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 06/24/2010 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/790,359 | Applicant(s) RUTAN ET AL. | |
| | Examiner THOMAS WEST | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 8, 13, 16, 20, 22, 23, 26, 27, 30, 34, 35, 38, 41, 47, 49, 52, 55 and 58-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 8, 13, 16, 20, 22, 23, 26, 27, 30, 34, 35, 38, 41, 47, 49, 52, 55, 58-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in response to the Arguments/Remarks file January 11, 2010.
2. Claims 1, 7, 8, 13, 16, 20, 22, 23, 26, 27, 30, 34, 35, 38, 41, 47, 49, 52, 55, 58-68 are currently pending and have been examined.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, 8, 20, 22, 23, 26, 27, 30, 34, 38, 41, 47, 52, 55, 58-68 are rejected under U.S.C. 102(b) as being unpatentable over Inoue, U.S. Patent Application No. 2003/0028622.

Claims 1, 7, 16, 26, 27, 41, 47, 58-68:

Inoue, as shown, discloses the following limitations:

- requesting the electronic file, transferring the electronic file to the first client, and allowing an initial set of permissible actions with the electronic file regardless of a connection between the first client and the server, wherein the first client is a computer device (see at least paragraphs 105 cuts server connection, 115);

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- requesting a license from the server, transferring a first license to the first client, and allowing a first set of licensed actions by the first client with the transferred electronic file based on the first license regardless, wherein the first set of licensed actions is less restrictive than the initial set of permissible actions (see at least paragraphs 6, 45, 51, 105 cuts server connection, 115)
- transferring the electronic file to a second client; and (par. 58)
- upon the transfer of the electronic file, requesting a license from the server and modifying the first license, wherein the licensed actions of the modified license are more restrictive (ease or strengthen restrictions) than the first set of licensed actions. (see at least paragraphs 4, 85-94, 115)
- upon the occurrence of a license event, requesting a license from the server and modifying the first license (see at least paragraph 58)
- allowing an initial set of permissible actions with the electronic file regardless of a connection between the first client and the server, wherein the first set of licensed actions is less restrictive than the initial set of permissible actions (see at least paragraphs 45, 51, 117)
- transferring a second license to the second client that allows a second set of licensed actions with the electronic file (see at least paragraph 58)
- modifying the first license includes updating a license for a purchase/complaint (see at least paragraphs 37, 76, 105).

- modifying the first license includes revoking the license of the first client (see at least paragraph 106).
- transferring the electronic file to the first client (see at least paragraph 6, 45, 51)
- deleting the electronic file from the first client (see at least paragraph 106).
- modifying the first license includes revoking the license of the first client upon user request (see at least paragraph 106).
- opening/printing the electronic file on the second client (see at least paragraph 80, 116)
- modifying the first license includes revoking the license of the first client upon user request to enable the transfer of a second license to the second client (see at least paragraph 106)
- modifying the first license includes revoking the license of the first client upon user request to enable the creation of a second license for the second client (see at least paragraph 106).

Claim 22:

Inoue, as shown, discloses the following limitations:

- allowing a first/modified set of licensed actions regardless of a connection between the first client and the server (see at least paragraphs 105 cuts server connection, 115)

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Claims 20, 34, 52, 55:

Inoue, as shown, discloses the following limitations:

- further includes transferring a modified license to the first client and, upon receipt of the modified license from the server, allowing a modified set of licensed actions with the electronic file wherein the modified set of licensed actions is more restrictive (ease or strengthen restrictions) than the first set of licensed actions (see at least paragraphs 4, 85-94, 115)

Claims 8, 23, 30, 38:

Inoue, as shown, discloses the following limitations:

- receiving a license request from the second client and transferring a second license to the second client that allows a second set of licensed actions with the electronic file, and generating a second license based on an attribute of the second client, wherein the second set of licensed actions is substantially similar to the first set of licensed actions. (see at least paragraphs 38, 115)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13, 16, 35, 49 are rejected under U.S.C. 103(a) as being unpatentable over Inoue, U.S. Patent Application No. 2003/0028622 in view of Barber, US Patent No. 5,390,297.

Claims 13, 16, 35, 49:

Inoue discloses the request and transfer of a file from the first client to the second client and a more restrictive license, as shown above. Inoue does not directly disclose use of a dummy file or empty license, but Barber does, (col. 9, lines 27-68, col. 10, lines 1-68, col. 11, lines 1-28)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the request/transfer of the license of Inoue to include the empty license (dummy file) of Barber, since this aids in insuring the erasure/deletion of the original license file, preserving the security of issued licenses.

Response to Arguments

7. Applicant's arguments filed January 11, 2010 have been fully considered but they are not persuasive. Applicant's arguments will be addressed in sequential order as they were set forth in the "Remarks" section on the above date. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "transferring the electronic file

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to a second client”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Inoue teaches a more restrictive license, ease or strengthen restrictions, paragraphs 85-94. Inoue teaches further teaches transferring a file to a second client. “The parent terminal 6 is achieved by a PC and the like, requests the management server 5 to set usage restrictions for each child terminal 7 in the same home 3. The parent terminal 6 also relays data to/from the child terminal 7 by transferring the content request and the ticket request from the child terminal 7 to the management server 5 and transferring the requested content and the child license ticket from the management server 5 to the child terminal 7”, par. 58. Applicant argues that Inoue does not teach, “regardless of a connection...” Inoue discloses a logical cut in the server connection, paragraphs 105, 115. Applicant argues that Inoue does not teach “allowing an initial set of permissions due to the content distribution center, but Inoue allows content usage a license ticket, paragraph 37. Applicant argues that Inoue requires a connection between the child and parent terminal, but this is not claimed. Again, Inoue teaches a logical cut in the server connection, paragraphs 105, 115. Applicant argues that Inoue does not teach a licensing method for an electronic file, but Inoue teaches, “produces a license ticket that permits content use under the new usage rule, and sends the license ticket to the parent terminal (6)”, abstract. Applicant argues that Barber does not disclose use of a dummy file as part of a license request. Inoue discloses the request and transfer of a file from the first client to the second client. Barber discloses the use of an empty file

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(dummy file) as part of the request/transfer of a license, col. 9, lines 27-68, col. 10, lines 1-68, col. 11, lines 1-28. Barber discloses, "The license 27 so transferred is referred to as a "transferred license". In step 48, the license manager 25A causes the license 27 to be stored in the system memory 16 at the local node 14. The license manager 25A then takes path 49 to a step 50 that causes the operating system 15 at the local node 14 to create a new empty license file 22A on the local node 14 at which it is desired to use the copy of the computer program 24A" col. 11, lines 1-9.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-

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1236. The examiner can normally be reached on Tuesday and Wednesday 7:30am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West
Patent Examiner
Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621